

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAMI L. GUY,
JEFFREY L. BRIGGS and
ANNE L. MASON

Appeal No. 2005-1794
Application 09/965,405

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before GARRIS, PAK, and TIMM, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-23.

The subject matter on appeal relates to a method for a first organization to do business comprising authorizing a second organization to take an order from a customer wherein the order may be for a product or a service. Further details of this appealed subject matter are set forth in independent claims 1, 13, 18 and 19, which are all of the independent claims before us and read as follows:

1. A method for a first organization to do business comprising:

entering into a contractual relationship with a second organization;

Appeal No. 2005-1794
Application No. 09/965,405

authorizing said second organization to take an order from a customer, said order comprising at least one of:

products not produced by said first organization, and services not provided by said first organization;

receiving payment directly from said customer as a payment for said order taken by said second organization;

requiring an organization other than said first organization to ship products not produced by said first organization to said customer;

requiring an organization other than said first organization to provide services to said customer.

13. A method for a first organization to do business comprising:

requiring a second organization to take an order for sales items on behalf of the first organization;

in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization;

requiring the third organization to ship the product directly to a customer's address.

18. A method for a first organization to do business comprising:

requiring a second organization to take an order for sales items on behalf of the first organization;

in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization;

requiring the third organization to notify the first organization when the order exceeds a predetermined credit limit of the second organization.

Appeal No. 2005-1794
Application No. 09/965,405

19. A method for a first organization to do business comprising:

in response to a determination that services in a service order taken by a second organization on behalf of the first organization is incomplete determining whether the service order includes support services; and

determining a billing strategy based upon whether or not the service order includes support services.

The reference set forth below is relied upon by the examiner as evidence of obviousness:

Webber, Jr. (Webber) 6,167,378 Dec. 26, 2000

All of the claims on appeal are rejected under 35 U.S.C. § 103(a) as being unpatentable over Webber.

We refer to the brief and reply brief as well as to the final Office action (mailed December 15, 2003) and answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejection.

OPINION

For the reasons set forth below, this rejection cannot be sustained.

On the record before us, the examiner has failed to establish a prima facie case of obviousness with respect to the independent claim 1 limitation "authorizing said second organization to take an order from a customer," the independent claim 13 limitation

Appeal No. 2005-1794
Application No. 09/965,405

"requiring a second organization to take an order for sales items on behalf of the first organization," the independent claim 18 limitation "requiring a second organization to take an order for sales items on behalf of the first organization," and the independent claim 19 limitation "in response to a determination that services in a service order taken by a second organization on behalf of the first organization...." Each of these independent claim limitations involves a second organization taking an order on behalf of a first organization.

As correctly explained in the brief, the final rejection identifies the direct marketer and the winery in the column 12 example of Webber as respectively corresponding to the here claimed first organization and second organization. However, as also correctly explained in the brief, the Webber example contains no teaching or suggestion that the winery (i.e., second organization) takes an order for the direct marketer (i.e., first organization) as required by all of the appealed claims. To the contrary, in Webber's column 12 example, it is the direct marketer which takes orders on behalf of the winery.

Recognizing this deficiency, the examiner in the answer proffers an alternative identification of the business organizations disclosed in Webber which correspond to the first and second (as well as third) organizations claimed by the appellants.

Appeal No. 2005-1794
Application No. 09/965,405

This alternative identification appears on page 4 of the answer as follows:

Turning now to Webber, Jr., we see a system that has a first organization (an ISP, private provider, web page, etc.) which has entered into a contractual agreement with a second organization (broker, marketer) to take orders for a third organization (winery).

In the reply brief, the appellants have made the well-taken point that the examiner has failed to identify the specific Webber disclosure relied upon for supporting his alternative identification. According to the appellants, the examiner seems to be relying on the disclosure in lines 13-23 of column 6 which refers to a system "physically independent of the parties, wherein the business of the trading partners of the supply chain is conducted" (id. at lines 14-15) and which teaches that "[t]he system may operate advantageously as a private or an Internet Service Provider, ISP" (id. at lines 17-19). We share the appellants' view that the requirements of their independent claims are not achieved by considering the ISP or corresponding private party referred to by Webber as the here claimed first organization in accordance with the examiner's alternative position in the answer. Contrary to the examiner's belief, the ISP (or equivalent) of Webber's method is not a party to the business being transacted but instead is simply the mechanism by which the business transaction is effected. Moreover, the appealed claims require that the second

organization take an order on behalf of the first organization whereas the examiner on page 4 of the answer identifies patentee's marketer (second organization) as taking orders for the winery (third organization) rather than the ISP (first organization).

In addition to the foregoing, we agree with the appellants that the examiner also has failed to establish a prima facie case of obviousness for the independent claim 18 limitation "requiring the third organization to notify the first organization when the order exceeds a predetermined credit limit of the second organization" or for the independent claim 19 limitation "determining a billing strategy based upon whether or not the service order includes support services." On page 5 of the answer, the examiner refers to Webber's disclosure in lines 5-11 of column 12 as supporting an obviousness conclusion with respect to the claim 18 limitation. This disclosure concerns placement of a flag in the event of a dispute and contains no teaching or suggestion of a third organization notifying a first organization when an order exceeds a predetermined credit limit of a second organization. We are constrained by this circumstance to regard the examiner's obviousness conclusion as based upon impermissible hindsight. As for the claim 19 limitation, the examiner states that "Webber ... teaches such features as set forth in the final Office action" (answer, page 5). However, we find absolutely nothing in the

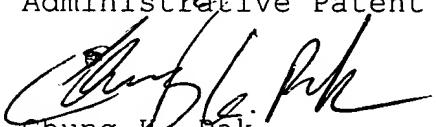
Appeal No. 2005-1794
Application No. 09/965,405

final Office action which discusses the billing strategy limitation of independent claim 19.

For the reasons set forth above, we cannot sustain the examiner's Section 103 rejection of claims 1-23 as being unpatentable over Webber.

The decision of the examiner is reversed.

REVERSED


Bradley R. Garris)
Administrative Patent Judge)

Chung K. Pak)
Administrative Patent Judge)

Catherine Timm)
Administrative Patent Judge)
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BRG/cam

Hewlett Packard Company
P O Box 272400, 3404 E. Harmony Road
Intellectual Property Admin.
Fort Collins, CO 80527-2400